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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,775	10/09/2001	Hyun Jin Kim	EKM-81582	6908

7590 03/31/2003
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48th Floor
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EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,775

Applicant(s)

KIM, HYUN JIN

Examiner

Raeann Gorden

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 22-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that method claim 22 does not specify a particular method for preparing the golf ball and any type of method falls within the scope of claim 22 since the claim only recites 'preparing' and 'incorporating' steps. This is not found persuasive, since applicant has only recited 'preparing' and 'incorporating' as a method of making the specification must be referenced to determine applicant's intent or meaning of 'preparing' and 'incorporating'. For example, the specification defines the step of preparing as dry-blending the composition or mixing the composition using a mill, internal mixer, or extruder. The step of incorporating is defined as injection molding the composition to form a spherical layer (pages 7 and 9). The steps described for making the golf ball of the present invention is one of several methods for making a golf ball.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the golf ball must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims include ratios compared to "ionomeric polymers and non-ionomeric polymers". However, the presence of both types of polymers was not established. See claim 10 were the composition includes "ionomeric polymers, non-ionomeric polymers or mixtures thereof". The "or" indicates that one of the three are possible but it is not clear which is actually included in the composition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Retford (3,992,014) in view of DiEdwardo et al (4,424,307). Regarding claims 1-8,

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Retford discloses a golf ball comprising a at least 60% cis-polybutadiene and the remainder 1,2-polybutadiene. Retford does not disclose properties of the composition. However, DiEdwardo teaches a syndiotactic 1,2-polybutadiene with more than 90% 1,2 units, an average molecular weight of more than 100,000 and a crystallinity from 15 to 25% (col 5, line 10;col 6, lines 54-59). Regarding claim 9, Retford discloses filler materials may be included in the composition (col 3, lines 10-19). Regarding claims 10-12, Retford discloses a golf ball comprising a at least 60% cis-polybutadiene and the remainder 1,2-polybutadiene. Retford does not disclose properties of the composition. However, DiEdwardo teaches a syndiotactic 1,2-polybutadiene with more than 90% 1,2 units, an average molecular weight of more than 100,000 and a crystallinity from 15 to 25% (col 5, line 10;col 6, lines 54-59). DiEdwardo also teaches an oxymethylene polymer is included in the composition (abstract). The ratio of the 1,2 polybutadiene and the polymer is from 1:99 to 20:80 (col 9, lines 35-42). Regarding claim 13, the polymer may be a copolymer (abstract). Regarding claim 14, Retford discloses also includes crosslinking agents (col 2, lines 30-35). One of ordinary skill in the art would have modified Retford with the 1,2-polybutadine and polymer of DiEdwardo to enhance the impact and durability of the golf ball (abstract).

Allowable Subject Matter

Claims 15-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on 7:30 AM to 5:00 PM Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Raeann Gorden
Patent Examiner
AU 3711

rg
March 24, 2003